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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,279	02/17/2004	Kazuhisa Takano	89277.0023	7069

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EXAMINER

YEAGLEY, DANIEL S

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/780,279	TAKANO, KAZUHISA	
	Examiner	Art Unit	
	Daniel Yeagley	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-15 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 7 – 11, 14, 15, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsunoda et al '622.

Tsunoda shows a motorcycle which encompasses a method for manufacturing a motorcycle, wherein a seat supporting member 11, 12 14 and 15 extend in a rearward direction from a body 10 with a seat placed on an upper plate-like seat supporting member 15 having connecting lower seat supporting members 14 that are configured as a plate-like member and are connected to and are separated in a downward direction from the upper seat supporting member and are shown covering a region above at least an exhaust pipe (figure 1), wherein the motorcycle comprises an engine 1 mounted on a body frame 10 with an exhaust pipe 3 connected to the engine and disposed below the seat (figure 1), wherein the seat supporting member is connected to the body frame by elements 11 and 12 of the seat supporting member and is configured such that the plate-like upper seat supporting member and lower plate-like seat supporting members form a hollow shape which opens in a downward direction to cover a region above at least an exhaust pipe 3 and means for covering a region surrounding a muffler 4 positioned above a rear wheel and would define a heat insulating space therebetween as broadly claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsunoda et al '622 in view of Hattori '366.

Tsunoda discloses a motorcycle comprising a seat supporting member made up of an upper and the lower seat supporting member which cover an exhaust pipe and a muffler, but failed to disclose the covering comprised of the upper and the lower seat supporting member being made of a heat insulating material of carbon resin.

Hattori discloses a motorcycle having a covering for covering an exhaust pipe 30 and muffler 32, wherein the cover over the exhaust pipe 30 is formed by a coating of synthetic resin plate with heat-insulating material as broadly claimed (column 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the exhaust pipe coverings of Tsunoda seat supporting members with some type of heat insulating material, such as a carbon resin or some other heat insulating material such as suggested by Hattori in order to prevent damage to the covers from excessive heat generated by an exhaust system and to further increase safety and comfort to the rider by insulating the rider from exhaust generated heat.

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5. Claims 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsunoda et al '622 in view of Ikenoya et al '306.

Tsunoda discloses a motorcycle comprising a seat supporting member which covers an exhaust pipe and muffler system, but failed to disclose an exhaust system containing a catalyst disposed inside a portion of the exhaust pipe which is covered.

Ikenoya shows a motorcycle with an exhaust system that is covered by seat supporting members, which further discloses the art of disposing a catalyst in a portion of the exhaust system if needed, (column 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the exhaust system of Tsunoda with a catalyst device disposed in the exhaust system if needed, as suggested by Ikenoya in order to provide a purification means to the exhaust system as is well known in the art and sometimes required by law.

Allowable Subject Matter

6. Although the amended claims 16 and 17 do not include the prior limitations of its preceding dependent claim 2, the claims are still considered allowable in their current status.

7. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 3/15/06 have been fully considered but they are not persuasive.

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Tsunoda clearly shows in figure 1 a motorcycle seat being integrally mounted with the upper plate-like member (cowling) and the integral lower plate-like members 14 (side covers) which are obviously supported by further elements 11 and 12 of the seat supporting member and therefore are readable on the claims as broadly recited. Wherein; just like that of applicants channel shaped seat supporting member, the seat is supported by the integral connection of the combined elements, not solely on the lower seat supporting members as argued. Figure 1 of Tsunoda further shows the side plates of the seat supporting structure extending above the exhaust pipe as viewed from the side of the motorcycle, and therefore clearly covers a *region* above the exhaust pipe as broadly claimed. Although Tsunoda shows a “forward portion” of the lower seat supporting member extending over and covering a region above the exhaust pipe, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *the forward portion 91a* of the lower seat supporting portion extends over and covers the region above the exhaust pipe) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In response to applicant's argument that Tsunoda does not disclose a structure of a hollow shape seat supporting member that defines a heat insulating space therebetween, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Tsunoda clearly suggests a hollow shaped seat supporting member, wherein the exhaust system is channeled thru the space

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within the seat supporting structure, wherein the air space within the seat supporting structure between the seat supporting structure and the exhaust pipe obviously defines a heat insulating space as broadly claimed.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanaka et al '144, figure 1-2, column 1, Muramatsu '725, Matsuzaki et al '264, Nozoe et al '508, Umeoka '016, Gogo '909, Watanabe '606, Matsuura et al '949 and Nakagome '452 show a motorcycle with the exhaust system covered by a seat supporting member.


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Yeagley whose telephone number is (571)-272-6655. The examiner can normally be reached on Mon. - Fri; first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on (571) - 272 - 6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D.Y.


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